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10/680,059	10/07/2003	Steve Searby	502453	8284

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EXAMINER
SPAHN, GAY

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	**Application No.** 10/680,059	**Applicant(s)** SEARBY, STEVE	
	Examiner Gay Ann Spahn	**Art Unit** 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2005*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.
4a) Of the above claim(s) *21-23* is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-4, 6-10,16-19,24 and 25* is/are rejected.
7)☒ Claim(s) *5,11-15,17,20 and 25* is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a)☐ All b)☐ Some * c)☐ None of:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the invention of Group I (claims 1-16 and 17-20, drawn to an underground cable laying apparatus and an apparatus for laying cable under turf, respectively, classified in class 37, subclass 347) in the reply filed on 11 July 2005 is acknowledged. The traversal is on the ground(s) that:

> [t]he Restriction Requirement is improper for the following reasons:
>
> 1. Pursuant to the provisions of MPEP § 704.01, "[w]hen an Examiner is assigned to act on an Application which has received one or more actions by some other Examiner, full faith and credit should be given to the search and action of the previous Examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, the second Examiner should not take an entirely new approach to the Application or attempt to reorient the point of view of the previous Examiner, or make a new search in the mere hope of finding something." Examiner Spahn has not alleged any clear error on the part of the previous Examiner, and therefore should give full faith and credit to the search and action of the previous Examiner.
>
> 2. No additional search should be required to proceed with prosecution of all of claims 1-23, or new claims 24-25. Any search required to examine claims 1-23, without restriction, has presumably already been performed by the Examiner previously assigned to the case, prior to issuing the previous two non-final Office Actions on the merits of claims 1-23. New claims 24 and 25 should also fall within the scope of the previous searches.
>
> 3. It cannot be shown by the Examiner that a search and examination of the entire Application causes a serious burden as required by Section 803 of the MPEP. Accordingly, the Examiner must proceed with examination of all claims, even if they are directed to independent or distinct inventions.

This is not found persuasive because the examiner has clearly set forth the reasons for restriction in her office action mailed 07 June 2005. Furthermore, the examiner has established burden since the apparatus claims are properly classified in class 37, subclass 347 and the method claims are properly classified in class 405, subclass 184.

Claims 21-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 13, 17, and 25 are objected to because of the following informalities:

(1) claim 13, line 2, a word such as --connected-- or --attached-- should be inserted after the word "operably";

(2) claim 17, line 6, the word "is" should be changed to --are--; and

(3) claim 25 cannot be dependent upon itself and since it appears that Applicants meant claim 25 to be dependent upon independent claim 24, the examiner will examine claim 25 as to the merits as if it were dependent upon claim 24.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-10, 16-19, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Brass et al. (U.S. Patent No. 4,009,668).

As to claim 1, Brass et al. discloses an underground cable laying apparatus (10), comprising:

a mounting yoke (unnumbered, but plate to which arms 45 and 55 and disk support 30 are attached);

a pair of angularly displaced turf slicing wheels (28) rotatably coupled to the mounting yoke, the turf slicing wheels (28) defining a forward contact area (see Fig. 4 and col. 3, lines 5-10) therebetween; and

a cable guide tube (56) positioned anterior of the forward contact area of the turf slicing wheels (28), the cable guide tube (56) having a cable inlet and a cable outlet.

As to claim 2, Brass et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Brass et al. also discloses that the pair of turf slicing wheels (28) are angularly displaced relative to one another along both a horizontal and a vertical axis of the mounting yoke.

As to claim 3, Brass et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Brass et al. also discloses a turf closure housing (unnumbered, see Fig. 10) pivotally coupled relative to the mounting yoke; and a pair of angularly positioned turf closing wheels (58) rotatably coupled to the turf closure housing.

As to claim 4, Brass et al. discloses the underground cable laying apparatus (10) of claim 3 as discussed above, and Brass et al. also discloses a pair of closure assembly mounting arms (see Fig. 10) fixably coupled to the mounting yoke, and wherein the turf closure housing is pivotally coupled to the closure assembly mounting arms.

As to claim 6, Brass et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Brass et al. also discloses a feed tube support extension member (see Fig. 1, structure in dashed lines above 30) coupled to the cable guide tube (56) in proximity to the cable outlet.

As to claim 7, Brass et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Brass et al. also discloses a cable guide (see Fig. 1, dashed circle above 56) coupled to the cable guide tube (56) and displaced from the cable inlet to aid in guiding cable into the cable inlet.

As to claim 8, Brass et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Brass et al. also discloses that the cable guide tube (56) is curved from the cable inlet to the cable outlet.

As to claim 9, Brass et al. discloses the underground cable laying apparatus (10) of claim 3 as discussed above, and Brass et al. also discloses a turf follower spring (59) coupled between the mounting yoke and the turf closure housing.

As to claim 10, Brass et al. discloses the underground cable laying apparatus (10) of claim 9 as discussed above, and Brass et al. also discloses a spring tension nut (see Fig. 1., at left end of dashed line outline of arm extending from 59) positioned to vary a bias force supplied by the turf follower spring (59).

As to claim 16, Brass et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Brass et al. also discloses that the mounting yoke includes at least one mounting receptacle (hole through which disk support 30 is mounted).

As to claim 17, Brass et al. discloses an apparatus (10) for laying cable under turf without leaving a visibly obvious scar in the turf, comprising:

a mounting yoke (unnumbered, but plate to which arms 45 and 55 and disk support 30 are attached) having at least one mounting receptacle (hole through which disk support 30 is mounted) defined therein;

a pair of turf slicing wheels (28) rotatably mounted on the mounting yoke, the turf slicing wheels (28) being positioned in a diverging relationship to one another and defining a forward contact area (see Fig. 4 and col. 3, lines 5-10) therebetween for opening a slit in the turf when the pair of turf slicing wheels are pulled therethrough; and

a cable feed tube (56) positioned between the pair of turf slicing wheels (28) and terminating in a cable outlet positioned to guide the cable into the slit opened by the pair of turf slicing wheels (28).

As to claim 18, Brass et al. discloses the apparatus (10) of claim 17 as discussed above, and Brass et al. also discloses a turf closure assembly (26) operably coupled to the mounting yoke and positioned relative to the pair of turf slicing wheels (28) to close the slit in the turf opened thereby anterior of the cable outlet.

As to claim 19, Brass et al. discloses the apparatus (10) of claim 18 as discussed above, and Brass et al. also discloses that the turf closure assembly (26) comprises a pair of turf closing wheels (58) angularly positioned relative to one another and laterally displaced from one another a distance greater than a lateral spacing at a trailing edge of the pair of turf slicing wheels (28).

As to claim 24, Brass et al. discloses an apparatus (10) for laying a cable under a lawn, the apparatus comprising:

a pair of angularly displaced turf slicing wheels (28) operatively coupled to one another in a manner defining a forward contact area (see Fig. 4 and col. 3, lines 5-10) therebetween for opening a slit in the lawn into which the cable may be guided.

As to claim 25, Brass et al. discloses the apparatus (10) of claim 24, wherein the pair of turf slicing wheels (28) are angularly displaced relative to one another along both a horizontal and a vertical axis of the mounting yoke.

Claims 1-4, 8-10, 16-19, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Jennings et al. (U.S. Patent No. 4,307,674).

As to claim 1, Jennings et al. discloses an underground cable laying apparatus (10), comprising:

a mounting yoke (11);

a pair of angularly displaced turf slicing wheels (29, 30) rotatably coupled to the mounting yoke (11), the turf slicing wheels (29, 30) defining a forward contact area (see Fig. 2) therebetween; and

a cable guide tube (15) positioned anterior of the forward contact area of the turf slicing wheels (29, 30), the cable guide tube (56) having a cable inlet and a cable outlet.

As to claim 2, Jennings et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Jennings et al. also discloses that the pair of turf slicing wheels (29, 30) are angularly displaced relative to one another along both a horizontal and a vertical axis of the mounting yoke (11).

As to claim 3, Jennings et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Jennings et al. also discloses a turf closure housing (see Fig. 3) pivotally coupled relative to the mounting yoke (11); and a pair of angularly positioned turf closing wheels (41, 42) rotatably coupled to the turf closure housing.

As to claim 4, Jennings et al. discloses the underground cable laying apparatus (10) of claim 3 as discussed above, and Jennings et al. also discloses a pair of closure assembly mounting arms (46, 47) fixably coupled to the mounting yoke (11), and wherein the turf closure housing is pivotally coupled to the closure assembly mounting arms (46, 47).

As to claim 8, Jennings et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Jennings et al. also discloses that the cable guide tube (15) is curved from the cable inlet to the cable outlet.

As to claim 9, Jennings et al. discloses the underground cable laying apparatus (10) of claim 3 as discussed above, and Jennings et al. also discloses a turf follower spring (see Fig. 1, 58) coupled between the mounting yoke and the turf closure housing.

As to claim 10, Jennings et al. discloses the underground cable laying apparatus (10) of claim 9 as discussed above, and Jennings et al. also discloses a spring tension nut (see Fig. 1., end of 57) positioned to vary a bias force supplied by the turf follower spring (58).

As to claim 16, Jennings et al. discloses the underground cable laying apparatus (10) of claim 1 as discussed above, and Jennings et al. also discloses that the mounting yoke (11) includes at least one mounting receptacle (hole through which bearings 31 are mounted).

As to claim 17, Jennings et al. discloses an apparatus (10) for laying cable under turf without leaving a visibly obvious scar in the turf, comprising:

a mounting yoke (11) having at least one mounting receptacle (hole through which bearings 31 are mounted) defined therein;

a pair of turf slicing wheels (29, 30) rotatably mounted on the mounting yoke (11), the turf slicing wheels (29, 30) being positioned in a diverging relationship to one another and defining a forward contact area (see Fig. 2) therebetween for opening a slit in the turf when the pair of turf slicing wheels (29, 30) are pulled therethrough; and

a cable feed tube (15) positioned between the pair of turf slicing wheels (29, 30) and terminating in a cable outlet positioned to guide the cable into the slit opened by the pair of turf slicing wheels (29, 30).

As to claim 18, Jennings et al. discloses the apparatus (10) of claim 17 as discussed above, and Jennings et al. also discloses a turf closure assembly (41, 42, 45, etc.) operably coupled to the mounting yoke (11) and positioned relative to the pair of turf slicing wheels (29, 30) to close the slit in the turf opened thereby anterior of the cable outlet.

As to claim 19, Jennings et al. discloses the apparatus (10) of claim 18 as discussed above, and Jennings et al. also discloses that the turf closure assembly (41, 42, 45, etc.) comprises a pair of turf closing wheels (41, 42) angularly positioned relative to one another and laterally displaced from one another a distance greater than a lateral spacing at a trailing edge of the pair of turf slicing wheels (29, 30).

As to claim 24, Jennings et al. discloses an apparatus (10) for laying a cable under a lawn, the apparatus comprising:

a pair of angularly displaced turf slicing wheels (29, 30) operatively coupled to one another in a manner defining a forward contact area (see Fig. 2) therebetween for opening a slit in the lawn into which the cable may be guided.

As to claim 25, Jennings et al. discloses the apparatus (10) of claim 24 as discussed above, and Jennings et al. also discloses that the pair of turf slicing wheels (29, 30) are angularly displaced relative to one another along both a horizontal and a vertical axis of the mounting yoke (11).

Allowable Subject Matter

Claims 5, 11, 12, 14, 15, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 13 would be allowable if rewritten to overcome the objection set forth in this Office action and if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-20, 24, and 25 have been considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various patents which are of interest for showing different configuration of turf slicing and closing wheels include: U.S. Patent No. 6,321,667 to Shoup; U.S. Patent No. 5,443,023 to Carroll; U.S. Patent No. 5,427,038 to Ege; U.S. Patent No. 6,314,897 to Hagny; U.S. Patent No. 5,645,000 to Carroll; U.S. Patent No. 4,878,443 to Gardner; U.S. Patent No. 4,275,671 to Baker; U.S. Patent No. 6,578,502 to Barnstable et al.; U.S. Patent No. 4,393,791 to Suderman; U.S. Patent No. 4,141,302 to Morrison, Jr. et al.; U.S. Patent No. 5,074,227 to Schwitters; and U.S. Patent No. 6,895,876 and U.S. Patent Application Publication No. 2003/0183141 to Bergere et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (571)-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gay Ann Spahn, Patent Examiner
October 20, 2005